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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ARTHUR W. DETORE and MARK K. CLARE

Appeal 2007-2073
Application 09/810,304
Technology Center 3600

Decided: June 25, 2008

Before JENNIFER D. BAHR, DAVID B. WALKER, and
JOSEPH A. FISCHETTI, *Administrative Patent Judges*.

FISCHETTI, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. §§ 6(b) and 134(a) (2002) from the final rejection of claims 19-32.

Representative claim 19 reads as follows:

19. A method of structuring contents of an unstructured domain so as to impart value to the domain, comprising the steps of:

identifying a plurality of elements of information associated with an unstructured domain;

developing an initial domain model for utilizing the plurality of elements of information associated with the domain to create value;

developing an estimate of costs associated with developing a knowledge map cataloging and describing at least some of said elements of information associated with the domain, and developing an estimate of the value of said knowledge map;

comparing the estimates of costs and value and, based on said comparison, performing at least one of the steps of:

storing and maintaining said model and said plurality of elements of information; and

developing and storing the knowledge map so as to add structure and impart value to said domain.

The reference set forth below is relied upon as evidence of anticipation:

Asplen	US 6,044,354	Mar. 28, 2000
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Claim 19 is the sole independent claim from which all dependent appealed claims depend. Claim 19 along with dependent claims 20-32 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Asplen¹.

It is the Examiner's position that Asplen's disclosure at col. 3 , ll. 49-67, col. 4, ll. 1-13 of an opportunity assessment chapter 2.0, which employs a feasibility determination of a proposed product based on detailed information of the product, constitutes developing an estimate of costs associated with developing a knowledge map as required by claim 19 (Answer 4).

¹ Although page 2 of the Final Action dated October 28, 2005 lists claims 1-18 as the claims subject to the final rejection, it is clear from the body of the rejection that the Examiner meant claims 19-32.

We agree with the Examiner that the collected detailed information about the product to be developed in the opportunity assessment 2.0 in Asplen would constitute a catalog of sorts in that as a collection, it is a further refinement of information. However, Asplen only discusses the feasibility of the product from “a technological, market and strategic perspective” (Asplen, col. 3 ll. 51-53), and not the cost associated with collecting the information as required by claim 19. *Webster 10th Collegiate Dictionary* defines feasible as 1: capable of being done or carried out. The definition of this word is thus not necessarily tied to cost as the Examiner’s reasoning implies, but rather only is driven by capability.

Even if one were to credit the definition of feasibility as cost feasibility as proposed by the Examiner, claim 19 still requires:

comparing the estimates of costs and value and, based on said comparison, performing at least one of the steps of:

storing and maintaining said model and said plurality of elements of information; and

developing and storing the knowledge map so as to add structure and impart value to said domain.

The Examiner cites to cols. 4-5 of Asplen in support of this limitation. We, however, cannot find that this claim limitation is disclosed in Asplen sufficiently to support sustaining a rejection under 35 U.S.C. § 102(e). “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 827 (1987). A review of Asplen at cols. 4-5 indicates that the comparisons discussed are those between a

budget and actual expenditure, and a budget and corresponding variations directed to implementing a product (Asplen, col. 5, ll. 10-13), but no cost benefit comparisons to determine whether to create the collection of information, e.g., a knowledge map (domain with additional structure), or leave information in the present model state. Accordingly, we cannot sustain the 35 U.S.C. § 102(e) rejection of claim 19 based on Asplen.

Since claims 20-32 depend from claim 19, and since we cannot sustain the rejection of claim 19, the rejection of claims 20-32 likewise cannot be sustained.

Accordingly we reverse the rejection of claims 19-32 under 35 U.S.C. § 102(b) as being anticipated by Asplen.

REVERSED

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